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PATENT
Customer No. 22,852
Attorney Docket No. 5725.0932-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re National Stage of International Application No.)
PCT/FR01/00229, filed January 24, 2001, of:)
)
Véronique FERRARI)
)
Application No.: 09/937,314) Group Art Unit: Unassigned
)
Filed: September 24, 2001) Examiner: Unassigned
)
371(c) date: December 6, 2001)
)
For: A TRANSFER-FREE MASCARA)
COMPOSITION COMPRISING AT LEAST)
ONE VOLATIVE SOLVENT AND AT LEAST)
ONE POLYMER (AS AMENDED))
)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO MAKE SPECIAL
UNDER 37 C.F.R. §1.102(d) AND M.P.E.P. § 708.02 (II)

In accordance with 37 C.F.R. §1.102(d), Applicant hereby petitions the
Commissioner of Patents and Trademarks to make this application special and receive
accelerated examination. Applicant is enclosing a check for \$130.00 to cover the fee for
this Petition as set forth in 37 C.F.R. § 1.17(h). If any additional fee is required in
connection with the filing of this Petition, please charge that fee to our Deposit Account
No. 06-0916.

03/02/2004 HUUONG1 00000015 09937314

01 FC:1460

130.00 OP

As set forth in M.P.E.P. § 708.02 (II), an application may receive accelerated examination when there is an infringing device or product actually on the market or an infringing method in use. The undersigned is aware of at least one product, having purchased a product sold under the trade name "MagnaScopic® Maximum Volume Mascara", currently on the U.S. market. A copy of the packaging in which the MagnaScopic® product is sold is attached as Exhibit A, pages 1-3.

The undersigned has performed a rigid comparison of the MagnaScopic® mascara product with at least one claim of the present application as pending from the Second Preliminary Amendment filed concurrently herewith. Even though Exhibit A at page 1 identifies the MagnaScopic® product as "Made in Canada," *i.e.*, outside the United States, the undersigned is of the opinion that at least one of the claims 133-153 in the present application is unquestionably directly infringed under 35 U.S.C. §271(a) by use of the MagnaScopic® mascara product sold as a mascara in the U.S. and used by consumers for the purpose intended by Estée Lauder's packaging and advertising, *i.e.*, as a mascara in a method of making up eyelashes. See Estée Lauder's webpage advertising the MagnaScopic® mascara product, Exhibit B at page 1, available at <http://www.estelauder.com> (referring to the MagnaScopic® Maximum Volume mascara and instructing product users to "[s]weep MagnaScopic® through lashes from root to tip, using tapered end to capture the finest lashes at inner corners. Repeat on lower lashes."); *see also* Claim Chart attached as Exhibit C.

Applicant previously submitted an Information Disclosure Statement on December 6, 2001, and submits herewith a Supplemental Information Disclosure Statement. The undersigned submits that, although no independent search has been conducted, the undersigned has a good knowledge of the pertinent prior art, in part

because the undersigned has identified 36 related co-pending applications and patents, wherein multiple Information Disclosure Statements have been filed and art has been uncovered, all of which is cited in the present application. Each reference deemed to be related most closely to the subject matter encompassed by the pending claims is listed on the Form PTO-1449 accompanying the Information Disclosure Statements or is already of record in this application.

Applicant respectfully submits that in view of the foregoing, the requirements of M.P.E.P. § 708.02 (II) have been met. Accordingly, Applicant requests that this Petition to Make Special be granted and that the examination and allowance of the pending claims, as presented in the Preliminary Amendment filed herewith, be accelerated.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2004

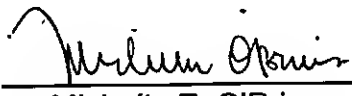
By: 
Michelle E. O'Brien
Reg. No. 46,203

EXHIBIT A

Packaging in which MagnaScopic® product is sold

[illegible]

MagnaScopic
01
BUCK

MADE IN CANADA 1T4F-01

MADE IN CANADA 1T4F-01



© ESTÉE LAUDER, DIST. NEW YORK, N.Y. 10022 LONDON W1K 3BQ 1T4F www.esleelauder.com

[illegible]

NET WT.
.3 OZ./9ml e



ESTÉE LAUDER

...and see your ophthalmologist at once.

CAUTION: In case of eye irritation, infection or scratches, discontinue use of all eye cosmetics and see your physician.

PRECAUTION D'EMPLOI : En cas d'irritation des yeux, d'infection ou de démangeaisons, interrompre l'utilisation de ce produit.

PRECAUTION D'EMPLOI : En cas d'irritation des yeux, d'infection ou de réaction allergique, arrêter l'usage du produit et consulter un médecin. Ne pas utiliser si vous êtes allergique au plus tôt. Soumis à des tests ophtalmologiques. Sans parfum.

et cunctis vultu: opusculum hoc ad p[ro]p[ri]am
curam: Bei Auftreten von Irritationen oder Infektionen am Auge: Anwendung jeglicher kosmetischer Produkte ist die Augenpflege zu unterlassen.

ACHTUNG: Bei Ausbruch von Krankheiten
Arzt aufsuchen. Augenärztlich getestet. Duffrei.

1T4F
01-

EXHIBIT B

**[http://www.esteelauder.com/templates/products/makeup_single_product.t
mpl?FAMILY_CODE=1t4f&CATEGORY_NAME=Mascara&SUPERCAT_NAM
E=Makeup](http://www.esteelauder.com/templates/products/makeup_single_product.t
mpl?FAMILY_CODE=1t4f&CATEGORY_NAME=Mascara&SUPERCAT_NAM
E=Makeup)**

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- Eyeliners
- Brows
- Mascara
- Blush
- Nails
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Makeup mascara

New. Hydra Complete Multi-Level Moisturizers. [Click Here.](#)



MagnaScopic
Maximum Volume Mascara
Magnify your lashes to the maximum—in a flash.

Engineered with revolutionary double patent-pending* technology: Expandex™ formula expands lashes to their fullest volume—up to 300% thicker. Speed-Meter Brush™, streamlined for precise handling, hugs the curves of every lash with supercharged color.

MagnaScopic: fast track to thick lashes.

Safe for contact lens wearers and sensitive eyes. Fragrance free, ophthalmologist-tested.

* U.S. and international patents pending.

Price: \$21.00

Works well with [Lash Primer Plus](#) and [Pure Color EyeShadow](#).

Shade	Qty	
Black	<input type="text" value="1"/>	add to cart
Brown	<input type="text" value="1"/>	add to cart
Purple	<input type="text" value="1"/>	add to cart

Shade	Qty	
Blue	<input type="text" value="1"/>	add to cart
Gilded Khaki	<input type="text" value="1"/>	add to cart

MAXIMUM VOLUME
Magnifies lashes up to 300% instantly, for a thicker, fuller, incredibly dramatic look.

MAXIMUM PRECISION
Unique brush design provides precise application and coats each lash evenly in one stroke.

MAXIMUM COLOR
Ultrasonically dispersed pigments create high-impact color—30% more intense.

MAXIMUM BENEFITS
Unique moisturizing complex forms a protective barrier that helps prevent breakage. Won't flake, smudge or clump.

HOW TO THICKEN YOUR LASHES
Sweep MagnaScopic through lashes from root to tip, using tapered end to capture the finest lashes at inner corners. Repeat on lower lashes.

[Browse Mascara](#)

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EXHIBIT C

Claim Chart

<u>Claim 146</u>	<u>MagnaScopic® Product</u>
A method of making up eyelashes comprising applying to said eyelashes a mascara comprising:	Webpage identifies MagnaScopic® as a mascara. The MagnaScopic® mascara product, although identified as made in Canada, is unquestionably sold in the U.S. as evidenced by the purchase of the product in Fairfax, Virginia by the undersigned. The infringement occurs directly by the consumer in applying the mascara to the eyelashes.
(i) at least one volatile solvent;	Product includes isododecane, a volatile solvent. See Line 1 of Ingredients listed on packaging.
(ii) at least one polymer chosen from ethylenediamine stearyl dimer tallate copolymers;	Product includes at least one ethylenediamine/stearyl dimer tallate copolymer. See Line 1 of Ingredients listed on packaging.
(iii) water;	Product includes water. See Line 1 of Ingredients listed on packaging.
(iv) at least one coloring agent; and	Product may contain mica, titanium dioxide, ferric ferrocyanide, iron oxides, ultramarines, blue 1 lake, bronze powder, blue 1, yellow 5, aluminum powder, bismuth oxychloride, carmine, chromium hydroxide green, chromium oxide greens, and/or yellow 5 lake. See Lines 5-7 of Ingredients listed on packaging. The product was purchased in the color black indicating that at least one coloring agent was present. Further, the web page www.esteelauder.com at Exhibit B recites "MAXIMUM COLOR" and states: "Ultrasonically dispersed pigments create high-impact color- 30% more intense."
(v) at least one preservative.	Product includes methyl paraben, butyl paraben, ethyl paraben, propyl paraben, and isobutyl paraben, all of which are known preservatives. See Line 5 of Ingredients listed on packaging.